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| 10/067,138 | 02/04/2002 | Spencer Kovner | 8296.6 | 7311 |

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EXAMINER

GREEN, BRIAN

ART UNIT PAPER NUMBER

3611

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,138

Applicant(s)

KOVNER, SPENCER

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10, 12-18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5, 12-18, 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claims 6-10 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Ristuccia, Sr. (U.S. Design Patent No. 310,098) in view of Goldman (U.S. Patent No. 3,496,665) or Roberts (U.S. Patent No. 42,260).

Ristuccia, Sr. discloses in figures 13 and 19 a business card holder comprising a thin sheet and a rectangular recessed area. Ristuccia Sr. discloses the use of an adhesive to secure the business card to the card holder. Ristuccia, Sr. does not disclose the idea of placing holes in the corners of the recessed area in order to hold the business card. Goldman shows in figures 1-4 the idea of placing holes (18) in each corner of a recessed area for allowing cards to be secured to the recessed area. Roberts shows in figures 1 and 2 the idea of placing slits or holes (b) in each corner of a recessed area for allowing cards to be secured to the recessed area. In view of the teachings of Goldman or Roberts it would have been obvious to one in the art to modify

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Ristuccia, Sr. by placing holes in each corner of the recessed area since this would allow cards to be attached and removed from the recessed area in an easier and more convenient manner. In regard to claim 14-18, these claims are article claims, product by process limitations are not given any patentable weight in article claims, i.e. how the article is made is not given any patentable weight in article claims.

6. Claims 12 and 14-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Ristuccia, Sr. (U.S. Design Patent No. 310,098) in view of McCabe (U.S. Patent No. 2,637,325).

Ristuccia, Sr. discloses in figures 13 and 19 a business card holder comprising a thin sheet and a rectangular recessed area. Ristuccia Sr. discloses the use of an adhesive to secure the business card to the card holder. Ristuccia, Sr. does not disclose the idea of placing holes in the corners of the recessed area in order to hold the business card. McCabe shows in figures 1-4 the idea of placing holes (46) in each corner with slits (42) extending from the holes for allowing cards to be secured to the holder. In view of the teachings of McCabe it would have been obvious to one in the art to modify Ristuccia, Sr. by placing holes in each corner of the recessed area since this would allow cards to be attached and removed from the recessed area in an easier and more convenient manner. The slits extending from the holes would allow different sized cards to be attached to the holder in a more secure manner. In regard to claim 14-18, these claims are article claims, product by process limitations are not given any patentable weight in article claims.

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7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ristuccia, Sr. (U.S. Design Patent No. 310,098) in view of Goldman (U.S. Patent No. 3,496,665) or Roberts (U. S. Patent No. 42,260) as applied to claim 14 above, and further in view of Dulin (U. S. Patent No. 5,076,490).

Ristuccia, Sr. in view of Goldman or Roberts disclose the applicant's basic inventive concept except for making the holder out of plastic. Dulin discloses in column 4, lines 65-68 the idea of making an index card out of plastic. In view of the teachings of Dulin it would have been obvious to one in the art to modify Ristuccia, Sr. by making the holder out of plastic since this would make the holder more durable.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ristuccia, Sr. (U.S. Design Patent No. 310,098) in view of McCabe (U.S. Patent No. 2,637,325) as applied to claim 14 above, and further in view of Dulin (U.S. Patent No. 5,076,490).

Ristuccia, Sr. in view of McCabe disclose the applicant's basic inventive concept except for making the holder out of plastic. Dulin discloses in column 4, lines 65-68 the idea of making an index card out of plastic. In view of the teachings of Dulin it would have been obvious to one in the art to modify Ristuccia, Sr. by making the holder out of plastic since this would make the holder more durable.

9. Claims 2,5, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ristuccia, Sr. (U.S. Design Patent No. 310,098) in view of Goldman (U.S. Patent No. 3,496,665)

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or Roberts (U.S. Patent No. 42,260) as applied to claim 14 above, and further in view of Finger (U. S. Patent No. 4,949,484) or Hanson (U.S. Patent No. 1, 867,218).

Ristuccia, Sr. in view of Goldman or Roberts disclose the applicant's basic inventive concept except for placing the card holder into a mounting device having at least one guide rail. Finger shows in figures 6,7,13, and 14 a mounting device (80) that includes side walls (82,86) and rails (92,94) extending between the side walls. Hanson shows in figures 1-4 a mounting device (10) that includes side walls and a rail (44) extending between the side walls. In view of the teachings of Finger or Hanson it would have been obvious to one in the art to modify Ristuccia, Sr. by making placing the card holder within a mounting device since this would allow a plurality of card holders to be supported in a convenient and orderly manner. It would have been obvious to one in the art to make the mounting device out of wood since this would create a more aesthetically pleasing display and to make the rails from a polymeric material since this would make the rails more durable. In regard to claims 2 and 21, the method of making the device is not given any weight in an article claim. Goldman and Roberts both show that the slits are angled at 45 degrees with respect to the lower edge.

10. Claims 2,4,5, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ristuccia, Sr. (U.S. Design Patent No. 310,098) in view of McCabe (U.S. Patent No. 2,637,325) as applied to claim 11 above, and further in view of Finger (U.S. Patent No. 4,949,484) or Hanson (U.S. Patent No. 1,867,218).

Ristuccia, Sr. in view of McCabe disclose the applicant's basic inventive concept except for placing the card holder into a mounting device having at least one guide rail. Finger

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shows in figures 6,7,13, and 14 a mounting device (80) that includes side walls (82,86) and rails (92,94) extending between the side walls. Hanson shows in figures 1-4 a mounting device (10) that includes side walls and a rail (44) extending between the side walls. In view of the teachings of Finger or Hanson it would have been obvious to one in the art to modify Ristuccia, Sr. by making placing the card holder within a mounting device since this would allow a plurality of card holders to be supported in a convenient and orderly manner. It would have been obvious to one in the art to make the mounting device out of wood since this would create a more aesthetically pleasing display and to make the rails from a polymeric material since this would make the rails more durable. In regard to claims 2 and 21, the method of making the device is not given any weight in an article claim.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ristuccia, Sr. (U.S. Design Patent No. 310,098) in view of Goldman (U.S. Patent No. 3,496,665) or Roberts (U.S. Patent No. 42,260) and Finger (U.S. Patent No. 4,949,484) or Hanson (U.S. Patent No. 1,867,218) as applied to claim 2 above, and further in view of Ristuccia, Sr. (U.S. Patent No. 4,849,056).

Ristuccia, Sr. in view of Goldman or Roberts and Finger or Hanson disclose the applicant's basic inventive concept except for printing indicia on the frame of the card holder. Ristuccia, Sr. '056 shows in figure 11 the idea of printing indicia (LAWYER) on the frame of the card holder. In view of the teachings of Ristuccia, Sr. '056 it would have been obvious to one in the art to modify Ristuccia, Sr. by printing indicia on the frame of the card holder since this would allow the holder to display additional information to users of the holder.

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Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ristuccia, Sr. (U.S. Design Patent No. 310,098) in view of McCabe (U. S. Patent No. 2,637,325) and Finger (U. S. Patent No. 4,949,484) or Hanson (U.S. Patent No. 1,867,218) as applied to claim 2 above, and further in view of Ristuccia, Sr. (U.S. Patent No. 4,849,056).

Ristuccia, Sr. in view of McCabe and Finger or Hanson disclose the applicant's basic inventive concept except for printing indicia on the frame of the card holder. Ristuccia, Sr. '056 shows in figure 11 the idea of printing indicia (LAWYER) on the frame of the card holder. In view of the teachings of Ristuccia, Sr. '056 it would have been obvious to one in the art to modify Ristuccia, Sr. by printing indicia on the frame of the card holder since this would allow the holder to display additional information to users of the holder.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ristuccia, Sr. (U.S. Design Patent No. 310,098) in view of Goldman (U.S. Patent No. 3,496,665) or Roberts (U.S. Patent No. 42,260) and Finger (U.S. Patent No. 4,949,484) or Hanson (U.S. Patent No. 1,867,218) as applied to claim 21 above, and further in view of Dulin (U.S. Patent No. 5,076,490).

Ristuccia, Sr. in view of Goldman or Roberts and Finger or Hanson disclose the applicant's basic inventive concept except for making the holder out of plastic. Dulin discloses in column 4, lines 65-68 the idea of making an index card out of plastic. In view of the teachings of Dulin it

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would have been obvious to one in the art to modify Ristuccia, Sr. by making the holder out of plastic since this would make the holder more durable.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ristuccia, Sr. (U.S. Design Patent No. 310,098) in view of McCabe (U.S. Patent No. 2,637,325) and Finger (U.S. Patent No. 4,949,484) or Hanson (U.S. Patent No. 1,867,218) as applied to claim 21 above, and further in view of Dulin (U.S. Patent No. 5,076,490).

Ristuccia, Sr. in view of McCabe and Finger or Hanson disclose the applicant's basic inventive concept except for making the holder out of plastic. Dulin discloses in column 4, lines 65-68 the idea of making an index card out of plastic. In view of the teachings of Dulin it would have been obvious to one in the art to modify Ristuccia, Sr. by making the holder out of plastic since this would make the holder more durable.

Response to Arguments

The applicant argues that independent claims 2, 14, and 21 includes the limitation that the holder is manufactured from a web of sheet material using a rotary die to form said holder by continuously feeding the sheet material through the die and the Board of Appeals and interferences gave weight to this limitation and allowed the claims in U.S. Patent No. 6,401,372. Claims 2, 14, and 21 are article claims, product by process limitations are not given any patentable weight in article claims, i.e. how the article is made is not given any patentable weight in article claims. The claims allowed in U.S. Patent No. 6,401,372 were method claims and this is why the Board of Appeals and interferences allowed the claims based upon the language

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“holder is manufactured from a web of sheet material using a rotary die to form said holder by continuously feeding the sheet material through the die”.

The applicant argues that Ristuccia, Sr. (Design) and Ristuccia, Sr. (Utility) fail to teach the use of a plurality of slits in the sheet to hold a business card. Ristuccia, Sr. (Design) and Ristuccia, Sr. (Utility) are modified in view of Roberts, Goldman, and McCabe to show that it is known to place slits on a sheet in order to hold a card. The use of slits would allow the card to be attached and removed from the holder in an easier and faster manner.

The applicant argues that Roberts, Goldman, and McCabe are in non-analogous art. The examiner disagrees since Roberts, Goldman, McCabe, Ristuccia, Sr. (Design), and Ristuccia, Sr. (Utility) are all directed to holders for retaining a card for display.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-4177.


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
Aug. 28, 2003